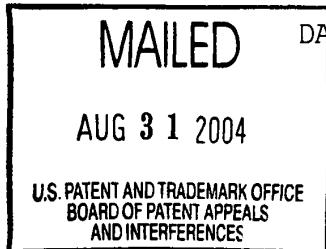


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MANSUKH M. PATEL,
DAVID R. PHILLIPS, III and CHUNGSEA A. SHEN

Appeal No. 2004-1781
Application No. 09/648,033

ON BRIEF

Before PAK, KRATZ and DELMENDO, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-20, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a chewing gum, a gum base and a method for making a chewing gum. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A chewing gum comprising:
 - a water insoluble portion not including a filler;
 - a water soluble portion including a flavor; and
 - approximately 3% to about 15% by weight lecithin.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Klose et al. (Klose)	4,246,286	Jan. 20, 1981
D'Amelia et al. (D'Amelia)	4,452,820	Jun. 5, 1984
Cherukuri et al. (Cherukuri '615)	4,518,615	May 21, 1985
Cherukuri et al. (Cherukuri '003)	4,794,003	Dec. 27, 1988

Claims 1-6 and 8-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cherukuri '615, Cherukuri '003 or D'Amelia. Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cherukuri '615, Cherukuri '003 or D'Amelia in view of Klose.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Having carefully considered each of appellants' arguments set forth in the brief and reply brief, appellants have not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejections for substantially the reasons set forth by the examiner in the answer. We add the following for emphasis.

Rejection of claims 1-6 and 8-20

Appellants state that they argue for the separate patentability of each of claims 1, 8, 14 and 18, the independent claims. Consequently, we consider those claims separately only to the extent justified by appellants' arguments. We note, however, that merely pointing out differences in the scope of claims is not considered to be an argument as to why the claims are separately patentable. See 37 CFR § 1.192(c)(7) and (c)(8) (2002). Here, appellants argue the claims together in the arguments section of the brief. Other than pointing out differences in what the independent claims cover in arguing against the examiner's § 103(a) rejection over Cherukuri '003 while making a generic argument thereagainst (see page 9 of

the brief, which argument will be further addressed below), appellants do not explain why each of the independent claims is separately patentable in a manner consistent with our regulations and practice over each of the three applied references. Nor do appellants separately argue any of the dependent claims. Thus, we consider claims 1-6 and 8-20 to stand or fall together on this record. Therefore, we select claim 1 as the representative claim on which we shall decide this appeal as to the examiner's first stated rejection because appellants have not separately argued the claims. See 37 CFR § 1.192(c)(7) and (c)(8) (2002) and In re McDaniel, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement, the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim").

Representative claim 1 requires a gum that includes a water insoluble portion without a filler, a water soluble portion including a flavor and lecithin in an amount of "approximately 3%

to about 15% by weight."¹ As pointed out by the examiner in the answer and the referred to Paper No. 5, each of the applied references teaches the option of using a gum base that includes no filler and optionally selecting lecithin as a gum ingredient in an amount that would overlap the representative claim 1 amount in forming a gum including a flavor ingredient in a water soluble portion. See, e.g., column 1, lines 10-21; column 3, lines 1-9, 27, 28 and 36; column 5, lines 1-4; column 5, line 57 through column 6, line 12; and column 6, line 34 through column 7, line 26 of Cherukuri '615; column 1, lines 10-18; column 2, lines 55-57; column 6, lines 7-11, 34-49, 63 and 64; column 7, lines 13-39 and 58-68; column 8, lines 36-68; and claim 19 at column 11 of Cherukuri '003; and column 1, lines 14-22; column 2, lines 55-61; column 3, lines 8-20; column 4, lines 27-46; column 5, lines 15-41; column 6, lines 1-24; column 7, lines 1-30; column 8, lines 6-26; column 9, lines 12-16; column 11, Examples 4-7; and column 14, lines 53-55 of D'Amelia. Based on the above referred to teachings of the references and

¹ We note that claim 1 is open to adding all of the lecithin to the gum base, all of the lecithin to the water soluble portion or some of the lecithin to each.

the findings of the examiner, we agree that the evidence relied upon by the examiner is sufficient to make out a prima facie case of obviousness of the subject matter of representative claim 1.

Appellants argue that Run D of Cherukuri '615² wherein no filler is disclosed as being used, employed no lecithin use either. However, comparative Run D of Cherukuri '615 is not an example in accord with the teachings of Cherukuri '615, but a comparative run as evidenced by the use of glyceryl triacetate therein, which emulsifier ingredient is described as unusable by Cherukuri '615. See column 5, lines 15-17 of Cherukuri '615. Consequently, appellants' observations about Run D of Cherukuri '615 in the briefs are somewhat disingenuous and certainly unpersuasive given the teachings of Cherukuri '615 as a whole. Appellants' assertion concerning columns 5 and 6 of Cherukuri '615 at page 8 of the brief are not persuasive of any error in the examiner's rejection. Certainly, the entire reference is available for all that it would teach or suggest to one of ordinary skill in the art. Moreover, the lack of an example that anticipates appellants' representative claim as basically argued

² Appellants refer to this reference as Cherukuri I.

by appellants does not establish that the evidence furnished by the examiner fails to satisfy all of the requirements for establishing a prima facie case of obviousness of representative claim 1.

Cherukuri '615 discloses that the water insoluble gum base preferably does not include any fillers (column 3, lines 6-9 and 36). Moreover, Cherukuri '615 teaches that gum generally includes a water soluble portion with flavoring agents in addition to the gum base. See, e.g., column 1, lines 10-21 and column 6, lines 10-27 of Cherukuri '615). An emulsifier is present in an amount of from about 2-10 weight percent of the gum base of Cherukuri '615 (column 3, lines 26 and 27). The gum base comprises about 5-45% of the gum according to Cherukuri '615 (column 6, line 37). Thus, Cherukuri '615 teaches that the gum includes up to about 4.5% (.10 X .45) emulsifier and that the emulsifier can be selected from a small group of materials including lecithin. See column 5, lines 1-4 of Cherukuri '615.

Representative claim 1 requires approximately 3 to 15 weight percent lecithin, an amount of lecithin which encompasses or overlaps the amount of lecithin taught by Cherukuri '615. In

this regard, it is well settled that when ranges recited in a claim overlap with ranges disclosed in the prior art, a prima facie case of obviousness typically exists and the burden of proof is shifted to the applicants to show that the claimed invention would not have been obvious. In re Peterson, 315 F.3d 1325, 1329-30, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003); In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990). For the reasons stated above and in the answer, appellants' arguments with respect to Cherukuri '615 teaching away from or not representing an enabling disclosure for a gum that includes no filler, flavoring and amounts of lecithin as claimed run counter to a fair reading of that reference. In this regard, we note that Cherukuri '615, a U.S. patent, enjoys a presumption of being enabling that has not been refuted with any evidence or persuasive scientific reasoning by appellants. Nor does appellants' contention that the lack of working examples in Cherukuri '615 that do not include filler in the gum represent a teaching away from the here claimed subject matter, even if such

were the case.³ This is so because "[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Here, based on the overall teachings of Cherukuri '615 as they would have been understood by one of ordinary skill in the art, there is ample motivation for one of ordinary skill in the art to have selected lecithin in amounts as here claimed and the absence of filler in the gum base as here claimed in formulating a gum product so as to obtain the non-adhesive chewing gum desired by Cherukuri '615 by simply following the directions given in Cherukuri '615. That there exist other options of using a few different ingredients for the emulsifier and/or optionally adding some filler to the gum of Cherukuri '615 is clearly not a teaching away from or evidence of a lack of motivation of using the no filler preference and lecithin option taught by Cherukuri '615 as

³ We note that the example 1, Run II gum formulation of Cherukuri '615 that is formed into gum sticks is not described as including filler.

another alternative. Appellants furnish no separate arguments with respect to the other appealed claims that the examiner rejects over Cherukuri '615 along with representative claim 1. It follows that we will sustain the examiner's § 103(a) rejection of claims 1-6 and 8-20 over Cherukuri '615.

Similarly, regarding the applied D'Amelia reference, appellants' contentions (brief, page 10) that D'Amelia teaches that fillers may optionally be employed and that an emulsifier other than lecithin is taught by D'Amelia are unpersuasive. As explained above in connection with Cherukuri '615, the mere fact that other alternatives are taught in D'Amelia does not take away from D'Amelia's teachings that lecithin and no filler can be employed with the lecithin being taught as being useful in amounts that overlap the amounts required by representative claim 1.

In this regard, we note that D'Amelia not only discloses the absence of filler in the gum base that is used in formulating the gum as an option, but claims such an option. See, e.g., column 5, lines 24-41 and claim 9 of D'Amelia. Moreover, D'Amelia discloses using 0 to about 10 weight percent lecithin as

an emulsifier in the gum base as an option and using about 10-40 weight percent gum base in the gum. See, e.g., column 6, lines 16-24 and column 7, lines 26-30 of D'Amelia.

For reasons analogous to those discussed above with respect to the application of Cherukuri '615 to representative claim 1, the disclosure of such overlapping amounts of lecithin as an option in D'Amelia fairly establishes the prima facie obviousness of the subject matter of representative claim 1.

The examiner furnishes no separate arguments with respect to the other appealed claims that the examiner rejects over D'Amelia. Consequently, we will sustain the examiner's § 103(a) rejection of claims 1-6 and 8-20 over D'Amelia.

Turning to the examiner's application of Cherukuri '003 under § 103(a) in rejecting claims 1-6 and 8-20, Cherukuri '003 also teaches the conventional use of water insoluble gum base and water soluble flavoring in forming gum including the option of using no filler, the option of using an emulsifier such as lecithin and using such an emulsifier in an amount that overlaps the amount of emulsifier employed in representative claim 1.

See, e.g., column 1, lines 10-18; column 2, lines 50-57;

column 6, lines 7-11 and 34-46; column 7, lines 61-68; and column 8, lines 36-38 of Cherukuri '003. We refer to our comments with respect to appellants' arguments being unpersuasive against the rejection over Cherukuri '615, and for similar reasons we find appellants' arguments unavailing with respect to the examiner's application of Cherukuri '003 in rejecting representative claim 1. In this regard, Cherukuri '003, like the other applied references, is simply not limited to the examples or some of the embodiments therein as appellants argue. Rather, each of the applied patents may be relied upon for all they would have reasonably conveyed to one having ordinary skill in the art.

See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); Merck & Co., Inc. v. Biocraft Labs., Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989).

We are cognizant that appellants mention the percent content of lecithin set forth in the other independent claims at page 9 of the brief along with the content of lecithin in representative claim 1 in arguing against the examiner's obviousness rejection over Cherukuri '003. While we do not consider that cryptic

reference to the lecithin content of the independent claims to amount to a separate argument for each of the independent claims in a manner consistent with 37 CFR § 1.192(c)(7) and (c)(8) (2002), we nevertheless will address those other independent claims to the extent justified by that mention of their respective lecithin content in comparison to Examples I and II of Cherukuri '003. Concerning independent claims 14 and 18, the at least 5 or 3 weight percent lecithin, respectively called for therein, overlaps the amount taught by Cherukuri '003. In this regard, Cherukuri '003 teaches using about 2 to about 10 weight percent emulsifier such as lecithin in the gum base and discloses that the gum includes about 5 to 60 weight percent gum base. Thus, Cherukuri '003 teaches using up to about 6 (.10 X .6) weight percent emulsifier (lecithin) in the gum, which overlaps the amount called for in those independent claims. Concerning independent claim 8, the at least 20 weight percent lecithin in the gum base called for therein has been found to be an amount of lecithin that would have been arrived at by one of ordinary skill in the art upon routine experimentation to determine the optimum or workable range of lecithin content according to the examiner

(answer, page 3). Appellants do not directly address that determination of the examiner in the briefs. Moreover, we note that the examiner's determination regarding the use of such a higher amount of lecithin in the gum base is supported by the applied references in that each of the cited references teach that conventional ingredients, such as plasticizers and/or softeners may optionally be added to the gum base. See, e.g., column 6, lines 63-66 of Cherukuri '003; column 5, lines 42 and 43 of Cherukuri '615; and column 6, lines 1-15 and column 4, lines 27-46 of D'Amelia, which latter reference discloses that lecithin is also useful as an additive conventional plasticizer or softening agent. Consequently, the addition of further amounts of lecithin to not only function as an emulsifier but to function as a softening agent and/or plasticizer would have been reasonably suggested by each of the applied references to one ordinarily skilled in the art.

Under the circumstances recounted above, it is our determination that the evidence of record for and against a conclusion of obviousness, reconsidered in light of the respective arguments and evidence advanced by appellants and the

examiner, on balance, weighs most heavily in favor of an obviousness conclusion with respect to the rejection under consideration. Accordingly, we shall sustain the examiner's § 103(a) rejection of claims 1-6 and 8-20.

Concerning the examiner's separate § 103(a) rejection of dependent claim 7 further employing the teachings of Klose to show the obviousness of employing antioxidant and color ingredients in the gum of the primary references, appellants do not contest that rejection on any basis other than the basis on which they contest the examiner's rejection of independent claim 1. It follows that we will also sustain the examiner's obviousness rejection of claim 7.

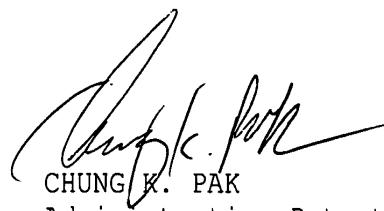
CONCLUSION

The decision of the examiner to reject claims 1-6 and 8-20 under 35 U.S.C. § 103(a) as being unpatentable over Cherukuri '615, Cherukuri '003 or D'Amelia and to reject claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Cherukuri '615, Cherukuri '003 or D'Amelia in view of Klose is affirmed.

Appeal No. 2004-1781
Application 09/648,033

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED



CHUNG K. PAK
Administrative Patent Judge)



PETER F. KRATZ
Administrative Patent Judge)

) BOARD OF PATENT
APPEALS
AND
INTERFERENCES



ROMULO H. DELMENDO
Administrative Patent Judge)

Appeal No. 2004-1781
Application 09/648,033

Bell, Boyd & Lloyd LLC
P.O. Box 1135
Chicago, IL 60690-1135